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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/622,017	07/16/2003	David Heller	APL1P288/P3054	1693
22434	7590	05/10/2007		
BEYER WEAVER LLP			EXAMINER	
P.O. BOX 70250			MEUCCI, MICHAEL D	
OAKLAND, CA 94612-0250				
			ART UNIT	PAPER NUMBER
			2142	
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			05/10/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/622,017

Applicant(s)

HELLER ET AL.

Examiner

Michael D. Meucci

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 February 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

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DETAILED ACTION

In view of the pre-appeal brief conference decision on 16 February 2007, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, Applicant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then Applicant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

Because new grounds of rejection are being made, this action is **non-final**.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1, 15, and 27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

3. The amendment filed 30 August 2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

- a. a proprietary format which is not understood by the second application program. Applicant is required to cancel the new matter in the reply to this Office Action. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 1, 15, and 27 are directed to a proprietary format which is not understood by the second application program. The applicant's specification mentions only database programs that are not normally able to read a database created by another database program, unless the database formats are the same or otherwise understood, e.g. proprietary, (see paragraph [0003] on page 1 of applicant's specification). Thus, specification is non-enabling towards this claim limitation.

- b. wherein said first application program is a music manager and player, and

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wherein said second application program is an image or video manager and viewer.

The applicant discloses both a music manager/player and an image/video manager/viewer, however there is no mention in the specification that the first application program is the music manager/player and the second application program is the image/video manager/viewer. Thus, specification is non-enabling towards this claim limitation.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1 and 15 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Claims 1 and 15 recite the limitation "a media content file." It is unclear as to whether the two recitations are meant to define separate media content files or if they are referring to the same media content file. For the purpose of applying art, it will be presumed by the examiner that any media content file is disclosed herein. Correction is required.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1, 15, and 27 rejected under 35 U.S.C. 102(e) as being anticipated by Lysenko et al. (U.S. 7,089,319 B2) hereinafter referred to as Lysenko.

a. Regarding claims 1, 15, and 27, Lysenko teaches: (a) accessing, by a second application program, a data communication file provided by a first application program. the first application program utilizing database data in a proprietary format not understood by the second application program, and the data communication file being derived from the database data such that data internal to the data communication file is acquired from the database data (lines 26-30 of column 3); (b) producing a user interface on the display using data internal to the data communication file (lines 39-43 of column 3); (c) receiving a user selection with respect to the user interface (lines 11-16 of column 2 and lines 34-36 of column 2); (d) identifying a media content file associated with the user selection (lines 36-40 of column 2); (e) associating a media content file identified by the user selection to the second application program (lines 24-36 of column 3).

b. Regarding claim 2, Lysenko teaches: wherein the data within the data communication file includes a link to the media content file (lines 28-37 of column 10).

c. Regarding claim 3, Lysenko teaches: wherein the media content file is stored in the data storage device by the first application program, and thereafter the

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media content file is useable by the second application program (lines 45-56 of column 8).

d. Regarding claim 4, Lysenko teaches: wherein said associating comprises presenting the media content file at the computer system (lines 28-38 of column 10).

e. Regarding claim 5, Lysenko teaches: wherein said associating comprises playing or displaying, within the second application program on the computer system, media content from the media content file (lines 28-38 of column 10).

f. Regarding claim 6, Lysenko teaches: wherein the user interface includes at least a menu of media items determined from data acquired from the data communication file provided by the first application program (lines 40-45 of column 5).

g. Regarding claims 7 and 8, Lysenko teaches: wherein the user interface is produced and said method is performed by the second application (lines 24-36 of column 3 and lines 28-38 of column 10).

h. Regarding claim 9, Lysenko teaches: wherein the data communication file is a markup language document (lines 28-34 of column 10)

i. Regarding claim 11, Lysenko teaches: wherein data within the data communication file pertains to media items managed by the first application program (lines 28-34 of column 10).

j. Regarding claim 12, Lysenko teaches: discloses that the data within the data communication file includes at least media item properties and links to storage locations for media content files containing media content for the media items (lines 28-34 of column 10).

k. Regarding claim 13, Lysenko teaches: said producing, said receiving, said identifying, and said associating are each able to be performed regardless of whether the first application program is being executed by the computer system (lines 3-19 of column 9).

l. Claims 11-13, 16-19, 21-23, 25, 26, 28-31, and 33-42 contain limitations similar to those disclosed in claims 1-9 and 11-13, and are rejected under the same rationale.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 10, 20, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lysenko as applied above, in view of Book et al. (U.S. 2003/0223566), hereinafter referred to as Book.

a. Regarding claims 10, 20, and 32, Lysenko does not explicitly disclose that the markup language document is an XML document. Book teaches that XML can be used to create a web page (par. 88, line 11). Lysenko and Book are analogous art because they are from the same field of endeavor of computing systems. At the time of invention, it would have been obvious to one of ordinary skill in the art that Lysenko's web page could be written in XML, as taught by Book. The motivation for doing so

would have been to enable Lysenko's invention to take advantage of the human readable tags that XML provides. It is for this reason that one of ordinary skill in the art at the time of the applicant's invention would have been motivated to use XML documents as the markup language documents in the system as taught by Lysenko.

10. Claims 14 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lysenko as applied above, in view of Perkes et al. (U.S. 2002/0194601 A1) hereinafter referred to as Perkes.

a. Regarding claims 14 and 24, Lysenko teaches: wherein said second application program is an image or video manager and viewer (lines 26-30 of column 3); and (claim 24 only) wherein the data communication file is stored on any of a first program, a second program or a third program (lines 23-35 of column 8). Lysenko does not explicitly teach: wherein said first application program is a music manager and player. However, Perkes discloses: "The consumer's selection is automatically detected and opens the media player required to play the type of media selected. If the Consumer activates the particular method implemented, the Guide will launch either a proprietary media player or any one of several widely distributed and well-known media player formats (such as Windows Media Player, RealPlayer or Apple's QuickTime Media Player), and display the preview of the content. For instance, if the content is a movie or video, the guide might play highlights of that content or a content provider supplied movie/video trailer may be shown. If the content is audio content, the guide might play highlights of the content, such as a portion of a musical piece or speech,"

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(paragraph [0071] on page 7). It would have been obvious for one of ordinary skill in the art at the time of the applicant's invention to have the first application program be a music manager and player. "These "teasers" would be used to encourage the consumer to play the previewed content, thereby increasing pay per views," (paragraph [0071] on page 7 of Perkes). It is for this reason that one of ordinary skill in the art at the time of the applicant's invention would have been motivated to have the first application program be a music manager and player in the system as taught by Lysenko.

Response to Arguments

11. Applicant's arguments with respect to claims 1-42 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kessler et al. (U.S. 7,170,999 B1) discloses file sharing environments with centralized listings.

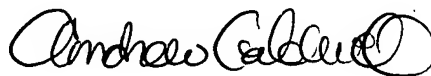
13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Meucci at (571) 272-3892. The examiner can normally be reached on Monday-Friday from 9:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell, can be reached at (571) 272-3868. The fax phone number for this Group is 571-273-8300.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [michael.meucci@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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